

REMARKS

This application has been carefully reviewed in light of the Final Office Action mailed March 1, 2004. At the time of the Office Action, Claims 1-20 were pending in the Application. Claim 16 has been amended to further clarify what the Applicants consider to be the invention. For the reasons discussed below, Applicants believe that the pending claims are allowable over the cited references. Therefore, Applicants respectfully request reconsideration and allowance of all pending claims.

Section 103 Rejections

The Office Action rejects Claims 1-3, 5-12, and 14-20 as being unpatentable over U.S. Patent No. 6,539,237 to Sayers et al. ("*Sayers*") in view of U.S. Patent No. 6,473,411 to Kumaki et al. ("*Kumaki*"), further in view of U.S. Patent No. 6,292,829 to Huang et al. ("*Huang*"). Claims 4 and 13 are rejected as being unpatentable over *Sayers* in view of *Kumaki*, further in view of *Huang*, and further in view of Newton's Telecom Dictionary, 13th Edition ("*Newton*"). Applicants traverse these rejections and all assertions therein for the reasons discussed below.

In order to establish a prima facie case of obviousness, three requirements must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge available to one skilled in the art, to modify a reference or combine multiple references; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or combination of references) must teach or suggest all of the claim limitations.¹ As will be described below, there is no suggestion, teaching, or motivation to combine the references, nor is there disclosure in the cited references, whether considered alone or in combination, of each and every limitation of the claimed invention.

No Suggestion, Teaching, or Motivation to Combine References

In the present case, a prima facie case of obviousness cannot be maintained for at least Claims 1, 10, and 16 because neither *Sayers*, *Kumaki*, nor *Huang* provide a suggestion, teaching, or motivation to a person of skill in the art to combine the references to achieve the present invention. *Sayers* is directed towards a communication system that allows users to

communicate freely between a public network and a private network, where the public network and the private network operate with the same protocol. (*Sayers*, Abstract). The Examiner cites to *Kumaki* merely to find support for the use of the Common Management Information Protocol (CMIP) to manage a network. (Final Office Action mailed 3/1/04, Page 3). *Huang* discloses the use of a gateway within a computer or other device coupled to a network, where the gateway is operable to convert between management protocols so that the device can support multiple protocols. (*Huang*, Col. 2, Lines 9-32).

To support the combination of the references, the Examiner merely stated that "it would have been obvious to a person with ordinary skill in the art at the time of the invention to incorporate the use of a protocol mediator as taught by Huang, et al. into the invention of Sayers, et al. in view of Kumaki et al. to achieve the advantage of enabling a network manager to manage multiple networks using a plurality of network management protocols." However, the Examiner has not pointed to any portion of *Sayers*, *Kumaki*, or *Huang* that supports this justification for the combination of references.

The M.P.E.P. and Federal Circuit case law support Applicants' position that a combination of references is improper in this case. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination.² The M.P.E.P. sets forth a strict legal standard for finding obviousness based on a combination of references. According to the M.P.E.P., "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge [that was] generally available to one of ordinary skill in the art" at the time of the invention.³ The "fact that references can be combined or modified does not render the resultant combination [or modification] obvious unless the prior art also suggests the desirability of the combination" or modification.⁴

¹ M.P.E.P. § 2143.

² See *Carella v. Starlight Archery*, 804 F.2d 135, 231 U.S.P.Q. 644 (Fed. Cir. 1986).

³ M.P.E.P. 2143.01.

⁴ *Id.* (emphasis in original).

The governing Federal Circuit case law makes this strict legal standard clearer.⁵ According to the Federal Circuit, "a showing of a suggestion, teaching, or motivation to combine . . . prior art references is an essential component of an obviousness holding."⁶ "Evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved."⁷ However, the "range of sources available . . . does not diminish the requirement for actual evidence."⁸ In *In re Dembiczak*, the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that proper evidence of a teaching, suggestion, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant's invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.⁹

Even a determination that it would have been obvious to one of ordinary skill in the art at the time of the invention to try the proposed combination is not sufficient to establish obviousness.¹⁰

In the present case, the Examiner has merely stated that "it would have been obvious to a person with ordinary skill in the art at the time of the invention to incorporate the use of a protocol mediator as taught by Huang, et al. into the invention of Sayers, et al. in view of Kumaki et al. to achieve the advantage of enabling a network manager to manage multiple networks using a plurality of network management protocols." (Final Office Action mailed

⁵ Note M.P.E.P. § 2145(X)(C) ("The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.").

⁶ *In re Sang-Su Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25 (Fed. Cir. 2000)).

⁷ *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999).

⁸ *Id.*

⁹ *Id.* (quoting *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)) (emphasis added) (citations omitted); see also *In Re Jones*, 958 F.2d 347, 351 (Fed. Cir. 1992) ("Conspicuously missing from this record is any evidence, other than the PTO's speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at" the claimed invention.).

2/12/04, Page 3). However, speculation in hindsight that "it would have been obvious" to make the proposed combination because the proposed combination would supposedly be helpful is insufficient under the M.P.E.P.¹¹ and governing Federal Circuit case law.¹² *Huang* fails to teach, suggest, or motivate the use of any form of management protocol intermediary between networks, as recited in Claims 1, 10, and 16. Furthermore, *Sayers* fails to describe using different management protocols in different networks, let alone the use of any form of management protocol mediation between networks. Consequently, the Examiner is improperly using the Applicants' disclosure as a blueprint for piecing together various elements of *Sayers*, *Kumaki*, and *Huang* to achieve the Applicants' invention.

Furthermore, with respect to Claims 6, 9, 14-15, and 20, the Examiner takes "official notice" that the limitations of those claims are "old and well known in the art." If the Examiner is relying on "common knowledge" or "well known" art, the Examiner should provide a reference pursuant to M.P.E.P. § 2144.03 to support such an argument. If the Examiner relied on personal knowledge to supply the required motivation or suggestion to combine the references, the Examiner should provide an affidavit supporting such facts pursuant to M.P.E.P. § 2144.03.

For at least the reasons discussed above, a prima facie case of obviousness cannot be maintained for Claims 1, 10, and 16 because the cited references fail to teach, suggest, or motivate a person of skill in the art to combine the references as proposed by the Examiner.

¹⁰ See *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988).

¹¹ See M.P.E.P. § 2145(X)(C) ("The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.")

¹² For example, in *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999), the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that evidence of a suggestion, teaching, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant's invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999 (quoting *W.L. Gore & Assoc., Inv. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)) (emphasis added) (citations omitted). See also *In Re Jones*, 958 F.2d 347 ("Conspicuously missing from this record is any evidence, other than the PTO's speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been met motivated to make the modification of the prior art salts necessary to arrive at [the claimed invention].").

Therefore, Applicants respectfully request reconsideration and allowance of Claims 1, 10, and 16, as well as all claims that depend from these claims.

The References Fail to Disclose, Teach, or Suggest All Elements of the Claims

In addition to the fact that the references fail to provide the necessary suggestion or motivation to a person of skill in the art to combine the references to achieve the claimed invention, a prima facie case of obviousness cannot be maintained because each of the references, whether considered alone or in combination, fails to disclose each and every element of the claimed invention. For example, Claim 1 recites "a protocol mediator coupled to the first and second wireless networks, the protocol mediator operable to translate between the first management protocol and the second management protocol." Claims 10 and 16 recite similar, although not identical, limitations. The Examiner claims that *Huang* discloses this limitation. (Final Office Action mailed 3/1/04, Page 3). *Huang* merely discloses a gateway built into a network device, such as a computer, that enables the *device* to support multiple protocols. (*Huang*, Col. 2, Lines 9-32). However, *Huang* fails to disclose that its gateway is a protocol mediator coupled to a first and second wireless network that is operable to translate between first and second management protocols that are used to manage first and second wireless networks, as recited in Claim 1, and similarly, although not identically, in Claims 10 and 16.

For at least this additional reason, a prima facie case of obviousness cannot be maintained for Claims 1, 10, and 16. Therefore, Applicants respectfully request reconsideration and allowance of Claims 1, 10, and 16, as well as all claims that depend from these claims.

Furthermore, Claim 5 recites that the first wireless network includes "a wireless adjunct internet platform (WARP) coupled to the base station and operable to communicate with the mobile station through the base station." The Examiner states that *Sayers* discloses this limitation. (Final Office Action mailed 3/1/04, Page 4). However, when rejecting Claim 1, the Examiner states that the first wireless network of Claim 1 was equivalent to *private* network 14 of *Sayers*. (Final Office Action mailed 3/1/04, Page 2). Yet, when rejecting Claim 5, the examiner states that the WARP is equivalent to BSC 16 of *Sayers'* *public*

network (which the Examiner equates to the *second* wireless network in Claim 1). Thus, assuming for the sake of argument that BSC 16 of *Sayers* is equivalent to a WARP, based on the Examiner's prior characterization of the networks in the rejection of Claim 1, *Sayers* discloses a WARP in the *second* wireless network, not in the first wireless network.

For at least this additional reason, a prima facie case of obviousness cannot be maintained for Claim 5. Therefore, Applicants respectfully request reconsideration and allowance of Claim 5, as well as Claims 6-9, which depend from Claim 5.

CONCLUSION

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending claims.

If the present application is not allowed and/or if one or more of the rejections is maintained, Applicants hereby request a telephone conference with the Examiner and further request that the Examiner contact the undersigned attorney to schedule the telephone conference.

Applicants do not believe that any fees are due. However, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 19-2179 of Siemens Corporation.

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Respectfully requested,

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